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Paper No. 50

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In re Application of: .
MILLS
Filed: January 20, 1998
Application No. 09/009,294
Dckt No.: 62-226-8A2

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition under 37 CFR 1.181(a)(3) filed September 17, 2002, to invoke the supervisory authority of the Director¹ to (1) overturn the decision of the Group Director of Technology Center 1700 (Group Director) of August 5, 2002, which refused withdrawal of the finality of the Office action of July 3, 2001, (2) withdraw the finality of the July 3, 2001, Office action, and (3) refund the extension, Notice of Appeal, and RCE fees paid.

The petition under 37 CFR 1.181(a)(3) filed September 17, 2002, requesting the decision of the Group Director of August 5, 2002, which refused withdrawal of the finality of the Office action of July 3, 2001, be overturned, and the finality of the July 3, 2001, Office action be withdrawn, is **DISMISSED AS MOOT**.

The petition under 37 CFR 1.181(a)(3) filed September 17, 2002, requesting that the fees paid for the requested extension(s) of time, Notice of Appeal, and RCE, be refunded, is **DENIED**.

¹ The title "Commissioner of Patents and Trademarks" was changed to "Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office" by § 4713 of the American Inventors Protection Act of 1999 (AIPA). See Pub. L. 106-113, 113 Stat. 1501, 1501A-575 through 1501A-577 (1999). As used in this decision, "Commissioner" or "Director" means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, and "Group Director" means the Group Director of Technology Center 1700.

BACKGROUND

The above-identified application was withdrawn from issue under the provisions of 37 CFR 1.313 on February 17, 2000, for purposes of reopening prosecution.

On September 1, 2000, a non final Office action was mailed. Claims 1 through 299 were rejected under 35 USC 101 and under 35 USC 112, first paragraph. The statements of the rejections made reference to decisional law and further relied upon and made specific references to an attached 8 page Appendix (which therein made specific reference to several monographs), Gilligan (U.S. 4,337,126), as well as monographs by Bethe et al., and applicant.

On February 21, 2001, an interview was conducted and memorialized by the Examiner's Interview Summary Form of the same date

On March 1, 2001, applicant filed, *inter alia*, a reply to the outstanding Office action.

On June 22, 2001, applicant filed a declaration under 37 CFR 1.132 which asserted its purpose was verifying experimental evidence already of record.

A final Office action was mailed July 3, 2001, which specifically incorporated the statement of the rejections made in the first Office action, addressed applicant's arguments in the reply of March 1, 2001, and the above-noted declaration, by way of an attached 68 page appendix.

On September 10, 2001, applicant filed a petition under 37 CFR 1.181, styled both as a request for reconsideration under MPEP 706.07 that the examiner withdraw the finality of the pending Office action of July 3, 2001, and also as a conditional petition under 37 CFR 1.181 to the Group Director requesting reconsideration if the examiner maintained the finality of the Office action of July 3, 2001. The petition alleged that the finality was premature in that new grounds of rejection had been introduced in the final office action that were neither necessitated by amendment nor based on information submitted in an Information Disclosure Statement. Applicant additionally urged that a clear issue between applicant and the examiner had not been developed

On November 23, 2001, the Group Director denied (see Paper No. 37) the petition for withdrawal of the finality of the outstanding Office action.

On November 19, 2001, applicant filed by facsimile transmission a request for reconsideration of the Group Director's adverse decision that was identified in the petition as Paper No. 37.

On January 3, 2002, applicant filed a request for a three month extension of time under 37 CFR 1.136(a) and the fee required by 35 U.S.C. 41(a)(8)(c) and 37 CFR 1.17(a)(3), an amendment under 37 CFR 1.116, and an Information Disclosure Statement. The amendment pointed to, *inter alia*, spectroscopic evidence of record, in support of applicant's contentions that the outstanding rejections should be withdrawn. Applicant asserted that the finality of the outstanding Office action was made in error and requested the finality be withdrawn. On the same date, applicant also filed a Notice of Appeal and the fee required by 35 USC 41(a)(6)(a) and 37 CFR 1.17(b).

The Advisory Action of February 22, 2002, indicated that the aforementioned amendment under 37 CFR 1.116 did not *prima facie* place the application in condition for allowance, treated outstanding Information Disclosure Statements, and also referred applicant to the Group Director's decision (specifically referencing paper No. 37) for treatment of the request for withdrawal of the finality of the outstanding Office action.

On May 15, 2002, the Group Director denied the request for reconsideration filed November 19, 2001.

On June 11, 2002, applicant filed a second request for reconsideration of the Group Director's decision.

On August 5, 2002, the Group Director denied the second request for reconsideration.

On August 5, 2002, applicant filed: a petition under 37 CFR 1.136(a) for an extension of time and the extension fee required by 37 CFR 1.17(a)(5); a Request for Continued Examination under 37 CFR 1.114 (RCE) and the fee required by 37 CFR 1.17(e); which sought consideration of the amendment previously filed under 37 CFR 1.116 on January 3, 2002, as the submission required under 37 CFR 1.114; an additional amendment/reply that added one new claim (no. 300); a declaration under 37 CFR 1.132; and an Information Disclosure Statement.

USPTO records indicate that the fees for the above-noted correspondence filed August 5, 2002, were processed on August 6, 2002, and the above-noted correspondence including the RCE were entered into the file of application No. 09/009,294 on August 20, 2002.

On September 17, 2002, applicant filed the instant petition which requests that the Director review the Group Director's decision of August 5, 2002, withdraw the finality of the Office action of July 3, 2001, as being premature, as well as refund the fees paid in filing the Notice of Appeal, the extension of time fees, and the fees for filing the RCE.

STATUTE AND REGULATION

35 U.S.C. § (2)(b)(2) provides, in pertinent part, that:

The Office...may establish regulations, not inconsistent with law, which...

- (A) shall govern the conduct of proceedings in the Office.

35 U.S.C. § 41(a) stated in pertinent part on January 1, 2002²:

(6)(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$320...

(8) For petitions for 1-month extensions of time to take actions required by the Director in an application--

- (A) on filing a first petition, \$110;
- (B) on filing a second petition, \$400; and
- (C) on filing a third petition or subsequent petition, \$920.

35 U.S.C. § 42(d) states:

The Director may refund any fee paid by mistake or any amount paid in excess of that required.

35 U.S.C. § 132(b) states:

The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

35 U.S.C. § 134(a) states:

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and

² Pursuant to 35 U.S.C. § 41(h)(1), these fees are subject to a 50% reduction for small business concerns, independent inventors or nonprofit organizations. .

Interferences, having once paid the fee for such appeal.

37 CFR 1.17(e) required in pertinent part on August 5, 2002 a fee:

To request continued examination pursuant to § 1.114:

By a small entity (§1.27(a)) \$370.00

37 CFR 1.26(a) provides in pertinent part:

The Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

37 CFR 1.116(a) states:

On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

37 CFR 1.114 provides in pertinent part:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

37 CFR 1.181(a) states:

Petition may be taken to the Commissioner:

- (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
- (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or

notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

OPINION

Petitioner requests (1) that the decision(s) of the Group Director, which refused withdrawal of the finality of the July 3, 2001, Office action be overturned, (2) the finality of the July 3, 2001, Office action in this application be withdrawn (*i.e.*, prosecution be reopened), and (3) the extension, Notice of Appeal, and RCE fees paid be refunded.³

35 U.S.C. 132(b) and its promulgating regulation 37 CFR 1.114 provide for the continued examination of an application at the request of applicant upon payment of a fee. Since, on August 5, 2002, the RCE had been filed on or after May 29, 2000, but prior to payment of the issue fee or abandonment of the application or the filing of any notice of appeal to the Federal Circuit or the commencement of a civil action; the application had been subjected to close of prosecution and was now under appeal to the Board of Patent Appeals and Interferences, as required by 37 CFR 1.114(b); and a timely submission and fee required by 37 CFR 1.114(c) had been filed; the RCE filed August 5, 2002, was proper.⁴ As such, by operation of 37 CFR 1.114(d), prosecution was reopened herein on August 5, 2002, by applicants own request (*i.e.*, the finality of the Office action of July 3, 2001, and the Notice Of Appeal of January 3, 2002, were withdrawn.) See 37 CFR 1.114(d).

As to the first two above-enumerated issues for which the Director's intervention is requested *i.e.*, review of the decision of the Group Director which refused to withdraw the finality of the Office action of July 3, 2001, as well as withdrawal of the finality of the Office action of July 3, 2001, these issues are moot due to petitioner's own Request for Continued Examination. Petitioner appears to overlook that the RCE request filed under 35 U.S.C. § 132(b) and 37 CFR 1.114 on August 5, 2002, has reopened

³ The petition also requests similar relief directed to other applications. Petitioner is reminded that 37 CFR 1.4(b) requires that any communication regarding issues in another application must be presented as a separate paper in that other application, and also that 37 CFR 1.5 requires that such communication must be appropriately captioned for that other application. This decision treats the petition solely as it relates to the above-identified application. See 37 CFR 1.4(b).

⁴ Since the Notice of Appeal was filed January 3, 2002, and as the extendible period obtainable under 37 CFR 1.136(a) ended on Saturday, August 3, 2002, the RCE and extension of time fees filed on the first business day thereafter *i.e.*, Monday, August 5, 2002, were timely. See 37 CFR 1.7(a).

prosecution in this application. That is, where, as here, a finally rejected application contains a Notice of Appeal, and is made the subject of a Request for Continued Examination, both the appeal and finality of the outstanding Office action are withdrawn, such that prosecution of the application is reopened. See 37 CFR 1.114(d). Thus, the finality of the Office action of July 3, 2001, has been withdrawn by way of the reopening of prosecution, since the date the Request for Continued Examination was filed by applicant (August 5, 2002). It follows that there is no remaining condition of finality within the meaning of 37 CFR 1.116, of which petitioner complains, to review or withdraw by way of the instant decision. Likewise, the requested review of the Group Director's decision is a moot action, because the involved issue of finality is a dead issue.

It is noted that the basis for petitioner's request(s) for withdrawal of the finality was that the first Office action had not accorded the same degree of consideration of experimental data and other technical evidence that was of record at that time, as had the second, final Office action. Since inspection of the record which will be before the examiner at the time of the forthcoming office action includes e.g., the arguments presented in the amendment filed January 3, 2002, and the submission filed with the RCE request on August 5, 2002, both of which refer to previous as well as newly filed experimental and technical evidence, the basis for applicant's current and previous petitions is not likely to recur.

As to the request for refund of the fees incurred since the final Office action while petitioner concurrently sought review on petition of the contested finality, this cannot be granted.⁵ 35 U.S.C. § 42(d) permits a refund of "any fee paid by mistake or any amount paid in excess of that required." Thus, the Patent and Trademark Office (PTO) may refund: (1) a fee paid when no fee is required (a fee paid by mistake); or (2) any fee paid in excess of the amount of fee that is required. See Ex Parte Grady, 59 USPQ 276, 277 (Comm'r Pats. 1943) (the statutory authorization for the refund of fees is applicable only to a mistake relating to fee payment).

However, petitioner has not shown that the fees in question were paid either by mistake or in excess. Petitioner does not assert, and inspection of the record fails to reveal, that the fees in question were paid by mistake. That is, each fee in question was owed at the time it was paid. As such, there is no mistake relating to the payment of each of the fees in question within the meaning of 35 U.S.C. 42(d). See Grady, supra. Likewise,

⁵ 37 CFR 1.181(f) requires that an applicant continue to prosecute the patentability issues of his application notwithstanding any requested review on petition of a procedural matter.

petitioner does not assert, and inspection of the record fails to reveal, that any of the fees in question were paid in excess of the amount owed. Rather, each fee in question was paid in the correct amount. As such, there is no excess fee paid within the meaning of 35 U.S.C. § 42(d) such that a refund is proper.

Indeed, as petitioner acknowledges, petitioner obtained the very result(s) for which the fees were paid: the pendency of the above-identified application was maintained. To now seek a refund of these fees after the intended result(s) has been obtained constitutes a change in purpose, which does not entitle a party to a refund. See 37 CFR 1.26(a). The patent statute and the rules of practice before the USPTO do not permit an applicant to request and pay for a conditional extension of time fee, a conditional Notice of Appeal fee, or file a conditional request and fee for continued examination, and depending on subsequent events, obtain a refund of the fee(s).

DECISION

The request to review the decision of the Group Director which refused to withdraw the finality of the Office action of July 3, 2001, as well as the request to withdraw the finality of the Office action of July 3, 2001, are **dismissed as moot** as the Request for Continued Examination filed August 5, 2002, has reopened prosecution and thus removed the finality of the Office action of July 3, 2001.

The request for refund of the extension of time fees, the Notice of Appeal fee, and the RCE fee is **denied**, as these fees were neither paid in error nor in excess.

The USPTO will not further consider or reconsider this matter. This decision may be viewed as a final agency action for purposes of seeking judicial review. See MPEP 1002.02.

This application is being returned to Technology Center 1700 for treatment of the RCE filed August 5, 2002.

Telephone inquiries related to this decision should be directed to Brian Hearn at (703) 305-1820.


Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy